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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,093	02/17/2000	Hyung-sik Choi	YPLA0002	7685

7590 02/24/2004
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EXAMINER

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ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 02/24/2004

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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 19

Application Number: 09/507,093
Filing Date: February 17, 2000
Appellant(s): CHOI, HYUNG-SIK

Jiawei Huang
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 11/28/03.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-3, 5 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,285,985	Horstmann	9-2001
5,781,894	Petrecca et al.	7-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 5 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 14 and reproduced below.

Claims 1-3,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann, patent number 6,285,985 in view of Petrecca et al., patent number 5,781,894.

Horstmann teaches an advertising method using software products comprising: making the software program stop in operation during the use of the software program when the advertisement is displayed (col. 3, lines 53-56, col. 4, lines 35-40). Horstmann also teaches accessing the web site of the sponsor by clicking on the web site address (col. 4, lines 10-20); and an advertisement window exists as another open window on the display (col. 4, lines 35-40, col. 3, lines 50-55). While Horstmann does not specifically state that the software program resumes only when the sponsored advertisement is clicked on, it would have been obvious to one having ordinary skill in the art to have allowed the program to resume by clicking on the advertisement since this would have been adopted for the intended use of allowing the user to regain control over the use of the application and increasing user satisfaction with the subsidized software while still

monitoring that ads are viewed by the user for the sponsors. It also would have been obvious to have downloaded the program since this is well known in the art for convenience in obtaining software and for obtaining software updates (upgrades).

Petrecca teaches an advertising method using software products in which at least one advertisement is inserted comprising: inserting at least one advertisement into at least one portion of the software program during the making of the software (col. 2, lines 40-60, col. 3, lines 20-35); wherein the software program with the inserted advertisement is reproducible and operable without connecting to the Internet (col. 1, lines 55-57, col. 2, lines 50-56) and where the program is free or at low cost (col. 2, lines 15-40). It would have been obvious to one having ordinary skill in the art at the time of the invention to have the software program with the inserted advertisement operable without connecting to the Internet as in Petrecca in the system of Horstmann since this would have allowed sponsors to reach more customers by providing another software distribution channel (disks). While Petrecca does not specifically state that the program is reproducible, it would have been obvious to one having ordinary skill in the art at the time of the invention to have allowed users to copy the program since this would have reached more potential buyers. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to have made the program stop operation to display the advertisement and resumed the program when the advertisement is clicked on as in Horstmann since this would have been adopted for the intended use of forcing the user to pay attention to the advertisement(s).

(11) Response to Argument

The appellant argues Horstmann does not teach inserting at least one advertisement into at least one portion of a software program contained in a software product during the making of the software product. Horstmann includes a subroutine during the making of the software program which is used to display advertisements.

However, the rejection was based on the combination of Horstmann and Petrecca. Petrecca teaches inserting at least one advertisement into at least one portion of a software program contained in a software product during the making of the software product as shown in the above rejection. The appellant argues that there is no motivation for combining Horstmann and Petrecca. However, motivation was provided in the rejection. First, Petrecca teaches at least one advantage of incorporating advertising messages into the software products "allows commercial sponsor to reach consumers who are not on network systems." This would allow advertisers to reach more customers than only those connected to a network in Horstmann. Second, motivation exists to combine the feature of stopping the operation to display the advertisement and resume the program when the advertisement is clicked on as in Horstmann (col. 3, lines 50-55) in Petrecca in order to force the user to pay some attention to the advertisement.

The appellant argues that inserting an advertisement into a software program during the making thereof would be against the intended purpose of Horstmann since the advertisement cannot be varied. The examiner disagrees. Horstmann teaches that a network connection is not needed every time. Instead, advertisements are stored and

shown when no network connection is available and, thus, does not need to be varied every time as the appellant suggests. Further, the success of the ad module is determined by the software developer, so the advertisement does not need to be varied at all (col. 4, lines 65-67). Thus, the combination with Petrecca is not against the intended purpose of Horstmann. Instead, the combination would allow advertisers to reach the users of Horstmann at least once before network connection particularly when the success of the ad module is deemed low.

The appellant also argues that the combination of Petrecca and Horstmann would behave differently than that of the present invention. However, Horstmann teaches that the user clicks on the advertisements (col. 3, lines 50-55, col. 4, lines 23-26) which provides some assurance to the advertiser that the messages was seen to some degree rather than the possibility that the user ignores the screen.

The appellant also argues that the software product is reproducible and operable without connecting to the internet. However, this language appears in a "wherein" clause which can be considered to be an optional step and does not limit the scope of the claim (MPEP 2106 II C) since the present invention also connects to the Internet as claimed in the dependent claims. Also, Petrecca teaches that the advertising message is stored on the same storage device as the software product which suggests the reproducibility in order to reach more customers and teaches that no network connection is needed.

The appellant also argues that Horstmann does not teach resuming the software program only when the advertisement is clicked on and does not teach an

advertisement inserting concept. However, Horstmann clearly teaches inserting and interrupting the software as shown in the rejection. Horstmann also teaches resuming the program when the advertisement is clicked on as in col. 3, lines 50-55. Further, it would have been obvious to resume the program only when the ad is clicked on since this would have increased user satisfaction by providing some control to the user rather than risk a negative reaction of the user frustrated by the lack of the ability to return to his task at hand. The appellant argues that there is no reference to resuming the program once the advertisement is clicked. However, this is shown in Horstmann (col. 3, lines 50-55) at least.

For the above reasons, it is believed that the rejections should be sustained.

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Art Unit: 3622

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Respectfully submitted,



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February 23, 2004

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